

BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Mike G. Roemmler

Application No. 09/802,707

Filed: March 8, 2001

For: METHOD OF MAKING EXPANDED GRAPHITE
WITH HIGH PURITY AND RELATED PRODUCTS

Appeal No. 2005-2368

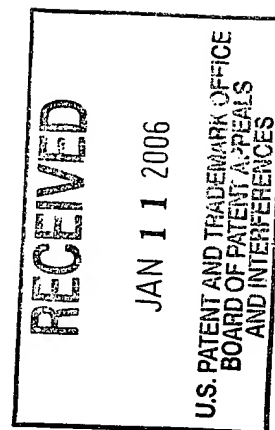
Examiner: List, Peter J.

Art Unit: 1754

REQUEST FOR RECONSIDERATION UNDER 37 CFR §41.52

Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:



In connection with the Decision on Appeal mailed September 23, 2005, Appellant respectfully requests a rehearing.

In the Decision on Appeal, the Patent Office found claims of Group I (claims 1-11, 13-21 and 23-27) obvious under 35 U.S.C. §103(a) over Greinke et al. (Greinke). According to the Patent Office, Greinke disclosed a process that is the same as the claimed invention except for the purification of the expanded graphite at a temperature of 1750°C. The Patent Office also noted that Greinke disclosed a purification of expanded graphite occurs at a temperature above 600°C and exemplifies the temperature of 1700°C. According to the Patent Office, a prima facie case of obviousness exists when the claimed range and the prior range do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. The Patent Office found the claims obvious and noted that Appellant had not argued that the claim temperature provides unexpected results.

As the Patent Office realizes, unexpected results is not the only basis for rendering claims not obvious over the cited references. In the particular case, Appellant argued that Greinke did not teach a temperature of at least 1750°C for the heat treatment and further there was no motivation for a person of skill in the art, based on the teachings of Greinke or the prior art of record to use a temperature of at least 1750°C for the heat treatment because Greinke, in essence, taught away from that temperature. It appears that the Patent Office overlooked or misapprehended this analysis as it was not addressed in the Decision on Appeal. Accordingly, Appellant requests that the Patent Office re-hear the pending appeal on that basis.

The argument that Appellant believes was misapprehended or overlooked is set forth in the Appeal Brief (see, pages 7-8) and is summarized below.

Greinke teaches that:

The purpose of the second heat treatment is to remove from the graphite surface, hydrophilic acid groups introduced either by the intercalant or by the acidic stabilization reagent, without removal of the desired hydrophobic stabilization functional groups, such as those which contain phosphorous or chlorine. Therefore, the second heat treatment should have a temperature limitation which is below the fracturing temperature of the stabilizing functional group but above the temperature required to remove the acid functional groups of above about 600°C. Greinke Col. 5, lines 38-47 (emphasis added).

The quoted passage suggests that there is an upper limit to the heat treatment of Greinke since there is an undesirable fracturing temperature. This upper limit must be about 1000°C since Greinke states, “the second heat treatment should go between 600° and about 1000°C for a controlled time period with a longer hold time required for the 600°C. temperature and a shorter hold time required for the higher 1000°C. temperature.” Greinke, Col. 5, lines 50-54. This suggests there is an upper limit and that upper limit is 1000°C since Greinke refers to “the higher 1000°C temperature,” the highest temperature in the range, in the singular. This also suggests that the fracturing temperature is 1000°C and any temperature above 1000°C would be unacceptable since it will cause the stabilizing functional group to fracture. Thus, one skilled in the art reading Greinke would not have had the proper motivation to use temperatures of at least 1750°C for fear of causing the stabilizing functional group to fracture.

Greinke shows examples that have a maximum temperature of 1700°C but does not suggest these examples are useful especially in light of the above argument that 1000°C is the highest allowable temperature, the fracture temperature, taught by Greinke. In addition, Example 10 of Greinke, which uses 1200°C, is equally non-suggestive since Greinke teaches that the product, which was supposed to be blister-free, blistered after only 90 days. See Greinke, Col. 7, lines 33-36. Therefore, there would be no motivation for one skilled in the art to look at temperatures above 1000°C when reading Greinke since each example resulted in an unacceptable product. Therefore, there is no teaching or suggestion in Greinke of a temperature of at 1750°C as recited in the claims of Group I. In fact, Greinke teaches away from extending a temperature from 1700°C to 1750°C. If anything, Greinke teaches using temperatures below 1000°C.

Additionally, to raise the temperature from the 600°C to 1000°C range to at least 1750°C requires greater power and thus, is more expensive to attain. Therefore, one skilled in the art would not be inclined to use a more costly, more difficult approach to accomplish the same task, especially in light of the fact that each of the examples at higher temperatures gave unacceptable results. Again, there is no suggestion or motivation in Greinke to use temperatures of at least 1750°C. Accordingly, it is requested that the anticipation/obviousness rejection of the independent claims of Group I be overturned.

As noted in its Appeal Brief and the Decision on Appeal, Greinke forms the basis for the rejection of the claims in each of Groups I-III. In view of the above arguments, Applicant requests rehearing of each of claims 1-27 and Groups I-III as the arguments presented above with Greinke apply equally well to those claims and groups.

CONCLUSION


Accordingly, it is submitted that the rejections of elements 1-27 based on 35 U.S.C. §103(a) be overturned.

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: November 22, 2005



William Thomas Babbitt, Reg. No. 39,591

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025
Telephone (310) 207-3800
Facsimile (310) 820-5988

CERTIFICATE OF MAILING:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Board of Patent Appeals and Interferences, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22314-1450, on November 22, 2005



Marilyn Bass

November 22, 2005

TRANSMITTAL FORM (to be used for all correspondence after initial filing)		Application No.	09/802,707
		Filing Date	March 8, 2001
		First Named Inventor	Mike G. Roemmler
		Art Unit	1754
		Examiner Name	Lish, Peter J.
Total Number of Pages in This Submission	7	Attorney Docket Number	71300P010

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> PTO/SB/08 <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Basic Filing Fee <input type="checkbox"/> Declaration/POA <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <div style="border: 1px solid black; padding: 5px; width: fit-content;"> Return Receipt Postcard </div>
Remarks Appeal Brief 2005-2368		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm or Individual name	William Thomas Babbitt, Reg. No. 39,591 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP	
Signature	<i>William T. Babbitt</i>	
Date	November 22, 2005	

CERTIFICATE OF MAILING/TRANSMISSION			
I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.			
Typed or printed name	Marilyn Bass		
Signature	<i>Marilyn Bass</i>	Date	November 22, 2005

Based on PTO/SB/21 (04-04) as modified by Blakely, Sokoloff, Taylor & Zafman (w/1) 06/04/2004.
 SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

RECEIVED
 JAN 11 2006
 U.S. PATENT AND TRADEMARK OFFICE
 BOARD OF PATENT APPEALS AND INTERFERENCES

RECEIVED
 NOV 29 PM 2:28
 BOARD OF PATENT APPEALS AND INTERFERENCES

FEE TRANSMITTAL for FY 2005

Petent fees are subject to annual revision.

Complete if Known

Application Number	09/802,707
Filing Date	March 8, 2001
First Named Inventor	Mike G. Roemmler
Examiner Name	Lish, Peter J.
Art Unit	1754
Attorney Docket No.	71300P010

☐ Applicant claims small entity status. See 37 CFR 1.27.

TOTAL AMOUNT OF PAYMENT

(\$)

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☒ None ☐ Other (please identify):

☒ Deposit Account Deposit Account Number: 02-2666 Deposit Account Name: Blakely, Sokoloff, Taylor & Zafman LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below

☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayment of fee(s)
under 37 CFR §§ 1.16, 1.17, 1.18 and 1.20.

☒ Credit any overpayments

FEE CALCULATION

Large Entity

Small Entity

Fee Code Fee (\$)

Fee Code Fee (\$)

Fee Description

Fee Paid

1051 130

2051 65

Surcharge - late filing fee or oath

1052 50

2052 25

Surcharge - late provisional filing fee or cover sheet.

2053 130

2053 130

Non-English specification

1251 120

2251 60

Extension for reply within first month

1252 450

2252 225

Extension for reply within second month

1253 1,020

2253 510

Extension for reply within third month

1254 1,590

2254 795

Extension for reply within fourth month

1255 2,160

2255 1,080

Extension for reply within fifth month

1401 500

2401 250

Notice of Appeal

1402 500

2402 250

Filing a brief in support of an appeal

1403 1,000

2403 500

Request for oral hearing

1451 1,510

2451 1,510

Petition to institute a public use proceeding

1460 130

2460 130

Petitions to the Commissioner

1807 50

1807 50

Processing fee under 37 CFR 1.17(q)

1806 180

1806 180

Submission of Information Disclosure Stmt

1809 790

1809 395

Filing a submission after final rejection (37 CFR § 1.129(a))

1810 790

2810 395

For each additional invention to be examined (37 CFR § 1.129(b))

Other fee (specify)

SUBTOTAL (2) (\$)

SUBMITTED BY

Complete (if applicable)

Name (Print/Type)

William Thomas Babbitt

Registration No.
(Attorney/Agent)

39,591

Telephone

(310) 207-3800

Signature

William T. Babbitt

Date

11/22/05

Based on PTO/SB/17 (12-04) as modified by Blakely, Sokoloff, Taylor & Zafman (wtr) 12/15/2004.
SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450